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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,055	05/29/2001	William A. Rozzi	10280US01 (EKC 90086)	5740

1333 7590 10/04/2005

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EXAMINER

MILIA, MARK R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/867,055	Applicant(s) ROZZI, WILLIAM A.	
Examiner Mark R. Milia	Art Unit 2622	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

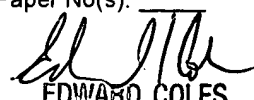
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached explanation.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


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DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 9/2/05, and has been entered and made of record. Currently, claims 1-42 are pending.

Response to Arguments

2. Applicant's arguments filed 9/2/05 have been fully considered. The Examiner agrees with a majority of the arguments set forth in pages 2-10, although some of the arguments are not supporting in the current claim language, as it is the Examiners burden to read the claims as broad as reasonably possible in light of the specification. Particularly, the examiner agrees that the references of Lipton, Swen, and Levy, taken by themselves, do not disclose the use of steganography to embed color properties and that the reference of Haikin does not disclose the limitations recited in claims 7 and 8. However, the arguments regarding the lack of motivation to combine the references of Lipton and Levy and the notion that the combination of these references does not disclose the claimed limitations are not persuasive. On page 5 of the arguments, it is stated that some of the references describe the embedding of color profiles or indicators into a document, particularly Lipton and Swen, and other references discuss steganography, particularly Levy. The Examiner would like to point out that this is the

basis for a rejection under 35 U.S.C. 103(a). More specifically, Lipton discloses a system that embeds color properties into an image and Levy discloses the use of steganography to embed watermarks into images during the raster image process. Steganography is a well known and commonly used technique to hide information by embedding the information in computer files such as graphics, text, sound, HTML, etc. Although Levy does not disclose using steganography to embed color properties of a device that generates an image, Levy does disclose embedding color watermarks into an image, the watermarks containing information related to color properties or the watermark and color properties of the location at which the watermark will be placed (see paragraph [0034] lines 1-6, and paragraphs [0038], [0040], and [0044]). The above shows that the references of Lipton and Levy do have similarities and are in the same field of endeavor. Particularly, both deal with embedding information into image data and both deal with color information.

3. In response to applicant's argument that the combination of Lipton and Levy would frustrate the goals of Lipton, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In particular, the reference of Lipton is used to show that steganography is a commonly used technique to embed information in raster image

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data and that it would have been obvious to one of ordinary skill in the art to modify Lipton with such a technique to embed color properties as Lipton states that one of ordinary skill in the art would readily recognize that there could be variations and modifications made that would be without departing from the spirit and scope on the invention (see column 6 line 64-column 7 line 3).

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available to one of ordinary skill in the art. Motivation can be found in the fact that steganography is a successful way to embed information as shown in the reference of Levy. This fact along with the teachings of Lipton regarding the embedding of color properties into image data clearly show that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of steganography as referenced by Levy with the system of Lipton.

Please note the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Young*,

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927 F. 2d 588,591,18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F. 2d 413,425,208 USPQ 871,881,(CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would be reasonably be expected to draw therefrom. In re Preda, 401 F. 2d 825,826,159 USPQ 342, 344 (CCPA 1968).

Therefore, under the current claim language and corresponding scope of the claims, the applicant's arguments as a whole are not considered to be persuasive.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRM

Mark R. Milia
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